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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,155	04/01/2004	Barry W. Townsend	183.39735AP7	7370

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ARLINGTON, VA 22209-3873

EXAMINER
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BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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05/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/814,155

Applicant(s)

TOWNSEND ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/16/2007; 11/17/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6, 7, 9-11, 13, 15, 16, 18, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, 9-11, 13, 15, 16, 18, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/22/2006; 3/27/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 16, 2007 has been entered.

### ***Response to Amendment***

2. Applicants' amendment of claims 1, 6, 7, 10, 13, and 15 in the reply filed on November 17, 2006 is acknowledged.
3. Applicants' cancellation of claims 8 and 19-22 in the reply filed on November 17, 2006 is acknowledged.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3, 6, 7, 9-13, 15, 16, 18, 23, and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. **7,108,723**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-3, 6, 7, 9-13, 15, 16, 18, 23, and 24 of the application and claims 1-21 of the patent lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1-21 of the patent is in effect a “species” of the “generic” invention of claims 1-3, 6, 7, 9-13, 15, 16, 18, 23, and 24. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-3, 6, 7, 9-13, 15, 16, 18, 23, and 24 of the application are anticipated by claims 1-21 of the patent, it is not patentably distinct from claims 1-21.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

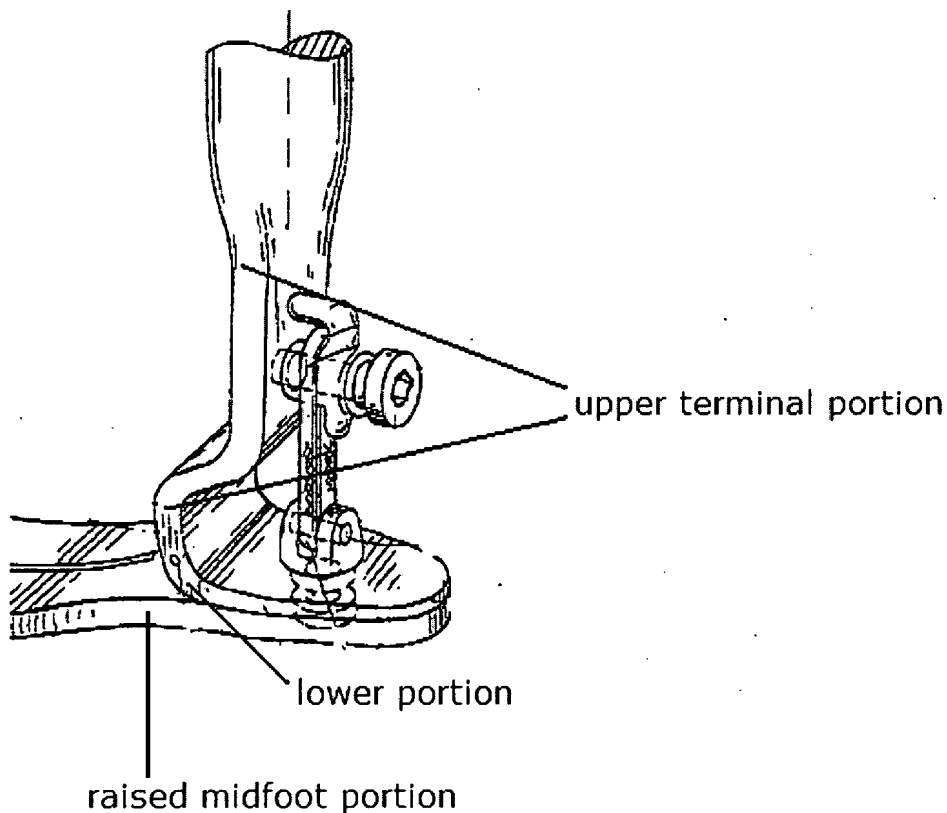
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7. Claims 1, 2, 6, 7, 9-11, 13, 15, 16, 18, 23, and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Atkinson et al. (US PG Pub No 2002/0087216 A1; cited in Applicants' IDS).

Referring to Figures 8, 9, 11, 13, 14, 19, and 29, Atkinson et al. disclose a prosthetic foot comprising:

- (i) A longitudinally extending foot keel having a forefoot portion, a raised midfoot portion, and a hindfoot portion; and
- (ii) A resilient, monolithically formed shank extending upwardly from the foot keel by way of an anterior facing continuous convexly curved surface with increasing radius of curvature to form a lower ankle joint area portion and an upper resilient shank terminal portion for connection with a lower extremity prosthetic structured secured to a person's residual limb; wherein the lower portion and the upper terminal portion of the shank extending upwardly from the foot keel are anterior facing convexly curved; and wherein the shank and at least the hindfoot portion of the foot keel are monolithically formed (i.e., "cast or formed from a single piece, element, or structure", as disclosed in paragraph 0082). The shank and foot keel are formed of metal or plastic (see paragraphs 0044 and 0047).

See Figure 11 of Atkinson et al. (US PG Pub No 2002/0087216 A1) below:



### *Response to Arguments*

8. With regards to the 102(b) rejection based on Atkinson et al. (US PG Pub No 2002/0087216 A1), Applicants' arguments filed November 17, 2006 have been fully considered but they are not persuasive.

a. The Applicants argue that Atkinson et al. (US PG Pub No 2002/0087216 A1) does not disclose "a raised midfoot portion", and "the upper terminal portion of the shank extending upwardly from the foot keel are anterior facing convexly curved". The Examiner respectfully disagrees. As shown above, Atkinson et al. prosthetic foot comprises "a raised midfoot portion" and "the upper terminal portion of the shank extending upwardly from the foot keel are anterior

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facing convexly curved”. The term “portion” or “terminal portion” is broadly interpreted. The shank has a straight vertical upper end (emphasis added), as claimed in claim 8.

**b.** With regards to “wherein the shank and at least the hindfoot portion of the foot keel are monolithically formed”, see paragraph 0082, wherein Atkinson et al. clearly disclose both structures as monolithically formed (i.e., “cast or formed from a single piece, element, or structure”).

9. Claims 1, 2, 6, 7, 9, 10, 11, 13, 15, 16, 18, 23, and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schneider (DE 298 20 904 U1; cited in Applicants’ IDS).

Referring to Figure 1, Schneider discloses a prosthetic foot comprising:

- (i)** A longitudinally extending foot keel having a forefoot portion (8), a raised midfoot portion (1/2), and a hindfoot portion (6/7); and
- (ii)** A resilient, monolithically formed shank (16) extending upwardly from the foot keel by way of an anterior facing continuous convexly curved surface with increasing radius of curvature to form a lower ankle joint area portion and an upper resilient shank terminal portion for connection with a lower extremity prosthetic structured secured to a person’s residual limb; wherein the lower portion and the upper terminal portion of the shank extending upwardly from the foot keel are anterior facing convexly curved; and wherein the shank and at least the hindfoot portion of the foot keel are monolithically formed. The shank and foot keel are formed of metal or plastic (see entire document).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Javier G. Blanco

April 29, 2007



**David H. Willse**  
**Primary Examiner**